

### **Remarks**

Claims 2, 4, 6-9, 11, 13 and 15-18 have been canceled without prejudice. Applicants reserve the right to pursue the canceled subject matter in one or more divisional applications. Support for the amendments to claims 3 and 12 can be found in the specification, for example, at page 4, lines 20-23, page 74, lines 11-14, page 84, lines 21-24 and Example 2. Thus, no new matter is added by the amendments to the claims. After entry of this amendment, claims 1, 3, 5, 10, 12, and 14 will be pending.

### **Objections to the claims**

Claims 5 and 14 were objected to under 37 CFR 1.75 as substantial duplicates of claims 4 and 13. Applicants respectfully traverse.

Claim 4 and 13 recite that the host cell is produced by the method of claims 3 and 12. In contrast, claims 5 and 14 do not have a limitation as to how the host cell is produced. Thus, the host cell of claims 5 and 14 could be made by methods other than those listed in claims in claims 3 and 12.

Although Applicants maintain that claims 5 and 14 are not substantial duplicates of claims 4 and 13, in the interest of furthering prosecution, Applicants have canceled claims 4 and 14. Therefore, this rejection is now moot.

### **Rejections under 35 U.S.C. §101**

Claims 2 and 11 were rejected under 35 U.S.C. §101 as being directed towards non-statutory subject matter in that the "composition" as recited could read on a human. Although Applicants disagree, in the interest of furthering prosecution, Applicants have canceled claims 2 and 11 rendering this rejection moot.

### **Rejections under 35 U.S.C. §112, first paragraph**

Claims 2, 3, 11 and 12 were rejected as failing to comply with the enablement requirement. Specifically, the claims were rejected as reading on introducing the pVGI.1 vector into a host cell in an *in vivo* setting. Claims 2 and 11 have been canceled, rendering the rejection moot with respect to these claims. Claims 3 and 12 have been amended to indicate that the host cell is produced *in vitro*. Applicants submit that the amendments to the claims overcome this rejection.

**Rejections under 35 U.S.C. §112, second paragraph**

Claims 1-5, 12 and 13 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for reciting "the pVGI.1 expression vector construct depicted in Figure 31" and for not indicating whether or not the "second host cell" recited in claims 3, 4, 12 and 13 is the same as the "first host cell". Applicants respectfully submit that the amendments to the claims overcome this rejection.

**Rejections under 35 U.S.C. §102(a)**

Claims 1-5 and 10-14 were rejected under 35 U.S.C. § 102(a) as anticipated by Vale et al. Applicants respectfully traverse.

To anticipate a claim, a reference must (1) disclose every element of the challenged claim and (2) enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996). Applicants respectfully submit that the Vale et al. reference does neither. The Vale et al. reference does not provide the nucleic acid sequence of the pVGI.1 vector or provide any indication of the elements (other than the VEGF-2 gene) that are present in the claimed vector construct. Thus, the cited reference does not disclose every element of the claimed invention. Additionally, the Vale et al. reference does not enable the claimed invention. Enablement requires that the prior art reference teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation. *See, Minnesota Mining and Manufacturing Co. v. Chemique, Inc.*, 303 F.3d 1294, 1301, (Fed. Cir. 2002). Because the Vale reference does provide any indication of the sequences or elements that are present in the pVGI.1 expression vector, one of skill in the art would not be able to make the claimed construct without undue experimentation.

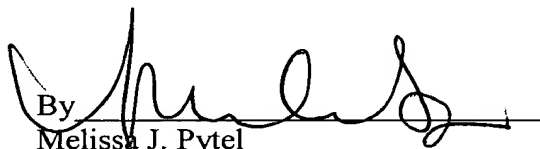
In summary, the Vale et al. reference is not an anticipatory reference because it does not disclose every element of the claimed invention, nor does the reference enable one skilled in the art to make the claimed invention. Applicants therefore request withdrawal of this rejection.

**Conclusion**

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

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